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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,643	07/15/2003	Philippe Schottland	134400-1	8576

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EXAMINER

RONESI, VICKEY M

ART UNIT PAPER NUMBER

1714

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/619,643

Applicant(s)

SCHOTTLAND ET AL.

Examiner

Vickey Ronesi

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 37.
Claim(s) objected to: _____.
Claim(s) rejected: 1-36.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Attachment to Advisory Action

The amendment filed 3/23/2006 has been entered. Applicant's response filed 3/23/2006 has been fully considered but is not persuasive.

Specifically, applicant argues (A) that none of the prior art discloses the purity of the 1,8-diaminoanthraquinone derivatives; (B) that Hunter teaches away from using 1,8-diaminoanthraquinone derivatives; (C) that Genta fails to motivate a skilled artisan to use 1,8-diaminoanthraquinone dyes with the presently claimed resins; (D) that Smith only teaches the use of 1,8-diaminoanthraquinones as an adjunctive dye; (E) that Smith, Orelup, and Genta are directed to different fields of art and one of ordinary skill in the art would not be motivated to combine them with any expectation of success; (F) that Turner does not disclose 1,8-diaminoanthraquinones; and (G) that one of ordinary skill in the art would not be motivated to combine Turner, which is directed to mouse infections, with Priester or Genta, which are directed to dye materials.

With respect to argument (A), while some of the prior art fails to explicitly disclose the purity, it is still considered that it would have been well within the capabilities of one of ordinary skill in the art to utilize pure, clean material, absent a showing of surprising or unexpected results had by having a purity of 90 wt % of greater. The standard of the examiner is not improper since pure materials are generally accepted as being desirable.

With respect to argument (B), Hunter teaches that 1,8-bis-cyclohexylaminoanthraquinone is not advantageously used in polyester systems, however, polyester is not a claimed resin. In fact, Hunter's disclosure strongly suggests that 1,8-bis-cyclohexylaminoanthraquinone is used in

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polymeric resins, just not advantageously in the high-temperature processing conditions of polyesters.

With respect to argument (C), Genta teaches that anthraquinone dyes are known dyes for polymeric materials. While Genta does not disclose 1,8-diaminoanthraquinone dyes, its teachings regarding anthraquinone dyes dying synthetic resins is still considered sufficient motivation to use the 1,8-bis-cyclohexylaminoanthraquinone of Hunter in other polymeric resins. Note that Genta's disclosure regarding poor color fastness of anthraquinones not containing phenylsulfonyl groups is only with respect to polyester resins.

With respect to argument (D), first, the presently claimed composition is open to other dyes as indicated by open claim language, "comprising." Second, it is not understood why an adjunctive dye would not be considered as a dye, just like the primary one, and thus just as obviously used.

With respect to argument (E), Smith, Orelup, and Genta disclose anthraquinone dyestuffs which are considered to be quite relevant fields. The fact that the dyes of Smith and Genta are used to prepared different products is remedied by Orelup, which provides the nexus and teaches that anthraquinone dyes are used in both tagging materials and polymeric resins.

With respect to argument (F), a 1,8-diaminoanthraquinone is immediately envisaged from Formula (I).

With respect to argument (G), Turner teaches that its material gives off color which would suggest a dye material. Further support for this is found in Priester which teaches a very similar compound that is used as a dye.

4/5/2006

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